



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,558	04/21/2004	Randell L. Mills	RMI-017	5441
959 7590 02/23/2009 LAHIVE & COCKFIELD, LLP FLOOR 30, SUITE 3000 ONE POST OFFICE SQUARE BOSTON, MA 02109				
EXAMINER				
POWERS, FIONA				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
02/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,558

Applicant(s)

MILLS ET AL.

Examiner

Fiona T. Powers

Art Unit

1626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 25-35, 37, 38, 71-77, 79-167, 172-174, 180, 181, 228 and 229 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 25-35, 37, 38, 71-77, 79-167, 172-174, 180, 181, 228 and 229 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Receipt is acknowledged of the amendment filed September 17, 2008, which has been entered in the file.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 20, 25 to 35, 37, 38, 71 to 77, 79 to 167, 172 to 174, 180, 181, 228 and 229 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims, the terms "having", "comprises" and "comprising" renders the claims indefinite because it is not clear what else the compound or dye can comprise. See claims 1, 20, 28-30, 34, 37, 79 and 80, for example.

In claim 30, periods appear within the claim. Note for example the bottom 10 lines on page 13 to page 15.

In claim 30, "n" which appears in the structure at the bottom of page 37 is not defined.

In claim 30, "and" should be inserted between the last two structures at the end of the claim on page 38.

Claims 73 to 77 are not further limitations of claim 1 because the structure of the compounds in claims 73 to 77 only

contains the A and B moieties but the compound synthesized in claim 1 also contains a C moiety and is of the formula A-B-C. In addition, the formula of the compound in claim 73 contains two "A" moieties whereas in claim 1 the compound only has one "A" moiety.

In claim 79, it is not clear why it is necessary to include the molecular formula and molecular weight for some of the formulas for C listed.

In claims 115 and 118, it appears that "or" should be inserted before "ester group" on line 3.

Claim 125 is not a further limitation of claim 105 which depends from claim 1 because the compound contains two "A" moieties whereas the compound synthesized in claim 1 only contains 1 "A" moiety.

In claim 157, it is not clear how a precursor aminophthalimide-linked B as recited on lines 10 to 11 on page 82 can be formed if a aminophthalic acid diester or other aminophthalhydrazide which is not a aminophthalimide as recited in step 4 on lines 7 to 7 on page 82 is used.

In claim 159, there appears to be language missing between "are" and "be" on line 11 or "be" should be deleted.

In claim 228, there are boxes within the compound names that appear to be missing numerals or symbols. See pages 91-94 and 96-98, for example.

The objections and rejections presented in the last office action which are not repeated herein have been overcome by amendment or cancellation of the claims.

Due to the submission of a new oath/declaration which specifies the citizenship of inventor Guo Zhang Wu, the oath/declaration is not longer defective.

Applicant's arguments filed September 17, 2008 have been fully considered but they are not persuasive.

With regard to the rejection of the claims because of the use of the terms "comprise" or "comprises" applicants states that the dyes or compounds can include additional additives or multiple dyes or compounds. However, the claims are drawn to a method of synthesis of a compound having the formula A-B-C. The inclusion of additional additives, dyes or compounds reads on the synthesis of compositions containing the compound A-B-C which may include additional active ingredients or diluents, for example, which were not contemplated by the inventors.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T.

Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/
Primary Examiner, Art Unit
1626

ftp
February 17, 2009